



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,959	09/17/1999	KARL ERIK STAHL	927.1003	9455
21171	7590	12/17/2008		
STAAS & HALSEY LLP			EXAMINER	
SUITE 700			DUONG, DUC T	
1201 NEW YORK AVENUE, N.W.				
WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER
			2419	
			MAIL DATE	DELIVERY MODE
			12/17/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/397,959

Applicant(s)

STAHL, KARL ERIK

Examiner

Duc T. Duong

Art Unit

2419

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 14-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 14-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding to claims 14 and 17, there does not appear to be a written description of the claimed limitation "means for initiating and receiving calls for a user in the **same home or office location as where said device is located**" in the application as filed. On page 6 line 15-page 8 line 6 of the specification discloses of means for initiating and receiving calls for a user using said device. However, the examiner found no such support for initiating and receiving calls for a user in a home or office of a same location as where the device is located. Such omission in the specification of the claimed limitation could suggest the device is located remotely of the home or office. Thus, it appears that applicants have incorrectly amended the claims by adding new matter into

the claims for the purpose of avoiding prior art. Claims 15-16 and 18-26 are also rejected for the same cited reasons since they depend on claims 14 and 17 and contain the same deficiency.

Regarding to claims 25 and 26, there does not appear to be a written description of the claimed limitation "first port is arranged to communicate with said wireless telecommunication network" in the application as filed. On page 1 lines 18-20, as cited by applicant, of the specification discloses the background of the invention in which cellular telephony is a variant of PSTN. However, the examiner found no such support in anywhere of the specification of the first port is arranged to communicate with said wireless telecommunication network.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 14-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14 and 17 recite the limitation "the same" on lines 4 and 8, respectively. There is insufficient antecedent basis for this limitation in the claims. Claims 15-16 and 18-26 are also rejected for the same cited reasons since they depend on claims 14 and 17 and contain the same deficiency.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 14-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al (US Patent 7,280,530 B2).

Regarding to claims 14 and 17, Chang discloses a system 2 for telecommunication utilizing both a circuit switched telecommunication network 16 and a packet based telecommunication network 18 (fig. 1 col. 10 lines 30-51), comprising multiple gateway telecommunication devices 4-8 (fig. 1) each having a first port (connection from PBX 34 to CO1) to connect said device to a circuit switched telecommunication network (fig. 2); a second port (connection from router 32 to IP network 18) to connect said device to a packet based telecommunication network (fig. 2); means 58 for initiating and receiving calls for a user in the same home or office location as where said device is located (fig. 3 col. 13 lines 54-63); means 73 for said user to interface with said device without using a telecommunication network (fig. 3 col. 15 lines 1-13); means 50 in said device for executing requests from said user to initiate

calls to parties on the circuit switched network or the packet based telecommunication network (fig. 3 col. 13 lines 54-63); and a single channel gateway means 58 (fig. 3 col. 13 lines 54-63) in said device 126 for establishing a path between said first port 167 and said second port 162 inside said device in response to a request from a server 26 on the packet based telecommunication network acting on behalf of a caller 38 at a remote location (fig. 6-7 col. 29 lines 18-36), whereby the gateway telecommunication device can serve as part of a distributed gateway system between said packet based telecommunication network and said circuit switched telecommunication network for said caller (fig. 3A col. 11 lines 62-66) and whereby the device increases the capacity of said distributed gateway system (col. 7 lines 33-48).

Regarding to claim 15, Chang discloses a third port 73 to connect a conventional telephone apparatus 74 via said device to said first port (fig. 3 col. 15 lines 1-13).

Regarding to claim 16, Chang discloses a mechanism to automatically connect said third port to directly to said first port in the event of a power failure (col. 5 lines 46-49).

Regarding to claim 18, Chang discloses gateway location servers P1-6' connected to said packet based telecommunication network, said gateway location servers being adapted to receive a request from a first gateway telecommunication device connected to said packet based telecommunication network for telecommunication with a specified telephone apparatus on said circuit switched telecommunication network, and further being programmed to select a second of said

gateway telecommunication devices to serve as a gateway between said networks for said requested connection, and to forward said request to said second gateway telecommunication device via said packet based telecommunication network (fig. 3A col. 12 lines 3-38).

Regarding to claims 19 and 20, hang discloses the packet based telecommunication network is the Internet (col. 10 lines 50-51).

Regarding to claims 21, 23, and 24, Chang discloses each of said gateway telecommunication devices includes means for registering with said gateway location servers the availability of said device to act as a gateway between said packet based network and said circuit switched network (col. 17 lines 44-62).

Regarding to claim 22, Chang discloses each of said registered gateway telecommunication devices includes means for automatically notifying said gateway location servers when its PSTN connection is Off Hook so it temporarily is not available to serve as a gateway between the packet based network and the circuit switched network (col. 47 line 66-col. 48 line 2) .

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Voit (US Patent 6,075,783).

Regarding to claims 25 and 26, Chang discloses all the limitations with respect to claims 14 and 17, except for the circuit switched telecommunication network comprises a wireless telecommunication network and the first port is arranged to communicate with the wireless telecommunication network. However, Voit discloses an Internet phone to PSTN cellular system comprising gateway server 14 with a port that's arrange to communicate with a cellular network 9 (fig. 2 col. 8 lines 45-49). Thus, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to arrange for such device for cellular network communication as taught by Voit into Chang's system to provide a methodology for facilitating telephone use of the Internet to complete calls from a landline device to a cellular device.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is (571)272-3122. The examiner can normally be reached on M-F (8:00 AM-5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. T. D./
Examiner, Art Unit 2419

/Wing F. Chan/
Supervisory Patent Examiner, Art Unit 2419
12/15/08